

**REMARKS**

Claims 1-6, 8-41, 43-76, and 78-113 are currently pending. No claims have been amended in this response.

In the Office Action<sup>1</sup> dated June 20, 2006, the Examiner: (1) rejected claims 1-6, 8-9, 14-41, 43-44, 49-76, 78-79, 84-105, and 112-113 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,055,573 to Gardenswartz ("*Gardenswartz*") in view of U.S. Patent No. 5,970,469 to Scroggie ("*Scroggie*"); (2) rejected claims 10-13, 45-48, and 80-83 under 35 U.S.C. § 103(a) as being unpatentable over *Gardenswartz* in view of *Scroggie*, and further in view of U.S. Patent No. 5,960,409 to Wexler ("*Wexler*"); and (3) rejected claims 106-111 under 35 U.S.C. § 103(a) as being unpatentable over *Gardenswartz* in view of *Scroggie* and further in view of U.S. Patent No. 5,945,653 to Walker ("*Walker*"). Applicant respectfully traverses the rejections under 35 U.S.C. § 103(a) and request the timely allowance of the pending claims.

**I. Rejection under 35 U.S.C. § 103(a) based on *Gardenswartz* and *Scroggie***

The Examiner rejected claims 1-6, 8-9, 14-41, 43-44, 49-76, 78-79, 84-105, and 112-113 as being unpatentable under 35 U.S.C. § 103(a) over *Gardenswartz* in view of *Scroggie*. Applicant traverses the rejection because the Examiner has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, the combination of references must teach or suggest all the claim elements.

Furthermore, "[a]ll words in a claim must be considered in judging the patentability of

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

that claim against the prior art.” See M.P.E.P. § 2143.01 (8<sup>th</sup> Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8<sup>th</sup> Ed. 2001), pp. 2100-122 to 127.

Independent claim 1, for example, recites a method for providing a purchase transaction incentive, comprising, among other things:

determining attributes of a first group of consumers in a market population of consumers who have purchased an item, wherein the market population of consumers is based on the stored transaction data and wherein at least one of the attributes includes at least one of:

financial information associated with the first group of consumers including at least one of primary payment type, bad check indicator, or information relating to bad checks; or

loyalty information associated with the first group of consumers including at least one of history of responses to loyalty offers, age, gender, or marital status.

With respect to claim 1, the Examiner asserts that *Gardenswartz* discloses the above-referenced limitations in view of the disclosure at col. 12, lines 29-56; col. 15, lines 55-65; and col. 4, lines 5-10 (Office Action at p. 4). Applicant respectfully disagrees with the Examiner’s conclusions.

In col. 15, lines 55-65, *Gardenswartz* discloses an “analytics unit” which “updates each consumer’s progress toward fulfilling a value contract based on the purchase history of the consumer in the purchase history database 8.” According to *Gardenswartz*, “progress may be determined by monitoring the purchases by a

particular consumer” and the “consumer may be identified by a frequent shopper or loyalty card, credit or debit card number, checking account number, or using any other identification.” *Gardenswartz* further discloses that “each time a consumer whose identification can be determined makes a purchase, the items purchased along with the consumer’s ID are stored in the purchase history database.”

*Gardenswartz*, thus, teaches monitoring a consumer’s purchase history, where the consumer may be identified by a frequent shopper or loyalty card, credit or debit card number, checking account number or using any other identification. However, *Gardenswartz* does not disclose the claimed step of “determining” attributes of a first group of consumers, wherein at least one of the attributes includes at least one of “financial information” or “loyalty information” associated with the first group of consumers, as defined in claim 1. The method disclosed by *Gardenswartz* does not determine such attributes with respect to a first group of consumers, but merely discloses using, for example, a credit or debit card number for identifying a consumer and storing that consumer’s purchase history. Because a consumer in *Gardenswartz* may be identified by a card or account number, for example, does not mean that *Gardenswartz* teaches or suggests “determining attributes of a first group of consumers” or let alone, “financial information associated with the first group of consumers including at least one of: primary payment type, bad check indicator, or information relating to bad checks,” as recited in independent claim 1.

In rejecting claim 1, the Examiner further relies on col. 4, lines 5-10 of *Gardenswartz* for its teaching of “targeting promotional incentives to consumers based upon said consumers loyalty to particular brands” (Office Action at p. 4). Applicant

respectfully disagrees. In the cited portion, *Gardenswartz* discloses that “delivery of promotional incentives to certain consumers may be avoided” (emphasis added). These consumers “may include consumers who already comply with the behavior or consumers whose purchase histories demonstrate a reluctance to remain loyal to a particular brand.” *Gardenswartz*, therefore, merely discloses that promotional incentives may be based on the “behavior” of a consumer. There is no teaching or suggestion in *Gardenswartz* of “determining attributes of a first group of consumers” wherein at least one of the attributes includes “financial information” (see above) or “loyalty information associated with the first group of consumers, including at least one of history of responses to loyalty offers, age, gender, or marital status,” as recited in claim 1.

In view of the foregoing, Applicant respectfully submits that *Gardenswartz*’s alleged teaching of monitoring a consumer’s purchase history or purchase behavior does not anticipate or render obvious the step of “determining attributes of a first group of consumers in a market population of consumers who have purchased an item . . . wherein at least one of the attributes includes at least one of financial information associated with the first group of consumers including at least one of: primary payment type or bad check indicator, or information relating to bad checks or loyalty information associated with the first group of consumers including at least one of history of responses to loyalty offers, age, gender, or martial status,” as recited in independent claim 1. Moreover, *Scroggie* does not overcome the deficiencies of *Gardenswartz* with respect to these limitations. Accordingly, the Examiner has failed to

establish a *prima facie* case of obviousness with respect to claim 1. Therefore, the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

Independent claims 36, 71, and 112, although of different scope, recite features similar to those of claim 1. As explained, the cited art does not support the rejection of claim 1. Accordingly, the cited art does not support the rejection of claims 36, 71, and 112, for at least the same reasons set forth above in connection with claim 1.

Claims 2-6, 8-9, 14-35, 37-41, 43-44, 49-70, 72-76, 78-79, 84-105, and 113 depend from independent claims 1, 36, 71, or 112. As explained above, the cited art fails to teach or suggest the recitations of claims 1, 36, 71, and 112. As such, the cited art also fails to support the rejection of these dependent claims for at least the same reasons set forth above. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by prior art. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-6, 8-9, 14-41, 43-44, 49-76, 78-79, 84-105, and 112-113 under 35 U.S.C. § 103(a) and allow the claims.

## **II. Other Rejections under 35 U.S.C. § 103(a)**

*Wexler* and *Walker* also fail to teach or suggest at least the above-identified recitations of the claims and, therefore, do not overcome the deficiencies of *Gardenswartz* or *Scroggie*. Accordingly, the cited art fails to support the rejection of claims 10-13, 45-48, 80-83, and 106-111 under 35 U.S.C. § 103(a) for at least the same reasons set forth above for their respective independent claims. In addition, each of these dependent claims recites unique combinations that are neither taught nor suggested by prior art. Therefore, Applicant respectfully requests that the Examiner

withdraw the rejection of claims 10-13, 45-48, 80-83, and 106-111 under 35 U.S.C.

§ 103(a) and allow the claims.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

A handwritten signature in black ink, consisting of a large, stylized 'G' followed by a smaller 'C' and a long horizontal stroke extending to the right.

By: \_\_\_\_\_

C. Gregory Gramenopoulos  
Reg. No. 36,532

Dated: December 20, 2006